

REMARKS

Applicants request reconsideration and allowance of the present application in view of the following remarks.

Claims 1-38 are pending in this application. Claims 1, 12, 27, 31, and 37 are the independent claims. Claims 31-38 were previously withdrawn from consideration as being drawn to a non-elected invention.

No claims have been amended by the present Request.

Claims 1-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,470,627 (Lee et al.) in view of U.S. Patent No. 5,016,240 (Strandjord et al.). This rejection is respectfully traversed.

Independent claims 1, 12, and 27 respectively recite, inter alia,

a substrate having ... micro-embossments, which are track guides ... (claim 1);

a substrate having a first surface ... with first protrusions extending from the first surface ... wherein the first protrusions are track guides (claim 12); and

first protrusions extending from a first surface (of a substrate)... wherein the first protrusions are track guides (claim 27).

Applicants respectfully submit that neither Lee et al. nor Strandjord et al. teaches or suggests at least the aforementioned features of independent claims 1, 12, and 27. Thus, without conceding the propriety of the asserted combination, the asserted combination of Lee et al. and Strandjord et al. is also deficient.

The Office concedes that Lee et al. does not teach or suggest micro-embossments protruding from the substrate. Thus, Lee et al. cannot teach or suggest micro-embossments or protrusions serving as track guides. Nonetheless, the Office contends that Strandjord et al. provides the requisite motivation to modify the teachings of Lee et al. to meet all of the claimed features. These contentions are respectfully traversed.

Strandjord et al. relates to an optical recording medium and teaches that "information is commonly stored on [read-only media] in the form of extremely small pits and/or protrusions" (Strandjord et al., Col. 1, lines 50-54). Strandjord et al. goes on to discuss that these pits and/or protrusions yield differences in a reflected light signal which are then electronically decoded. (Col. 1, lines 55-63). However, Strandjord et al. is silent as to using protrusions as track guides. Instead, the portion of Strandjord et al. relied upon in the Office Action teaches the conventional

knowledge of using pits and/or protrusions to store information.

Further, as the Office Action itself states, the combination of Lee et al. and Strandjord et al., assuming it were proper, yields a disc with protrusions or micro-embossments on a substrate. However, independent claims 1, 12, and 27 do not merely recite the presence of protrusions or micro-embossments on a substrate. Rather, these claims recite that micro-embossments (claim 1) or protrusions (claims 12 and 27) serve as track guides. The Office Action does not specifically contend that the asserted combination teaches or suggests, and Applicants submit that the asserted citations do not teach or suggest, the track guides of claims 1, 12, and 27.

The failure of these citations to disclose at least the aforementioned features of independent claims 1, 12, and 27 proves fatal to establishing a prima facie case of obviousness against these claims, since MPEP § 2142 requires that:

To establish a prima facie case of obviousness ... the prior art reference (or references when combined) must teach or suggest all the claim limitations.

For this reason alone, independent claims 1, 12, and 27 are allowable over the citations of record.

Independent claims 1, 12, and 27 patentably define over the asserted citations for another reason. MPEP § 2142 also requires, to establish a prima facie case of obviousness, that:

The references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

Here, as noted above, neither Lee et al. nor Strandjord et al. expressly or impliedly teach or suggest using micro-embossments (claim 1) or protrusions (claims 12 and 27) as track guides. Therefore, to establish a prima facie case of obviousness, the Office must present a convincing line of reasoning as to why one of ordinary skill in the art to modify the groove track guides of Lee et al. in view of the pits and/or protrusions for storing information of Strandjord et al. to yield micro-embossments or protrusions which serve as track guides.

The Office Action provides two reasons why one of ordinary skill in the art would modify the teachings of Lee et al. in view of Strandjord et al. First, it is stated that Lee et al. and Strandjord et al. are analogous art. Second, it is stated that Strandjord et al. supposedly teaches that "small protrusions improve the coding of information signals. (Office Action, page

3). However, regarding the Office's first reason, the mere fact that a reference can be modified is not sufficient to establish a prima facie case of obviousness. (MPEP 2143.01). And, regarding the Office's second rationale, it is respectfully submitted that the Office has erroneously characterized the teachings of Strandjord et al. Nowhere in any of the specific portions of Strandjord et al. on which the Office relies is it taught that providing small protrusions "improves the coding of information signals." (Office Action, page 3). Indeed, Col. 1, lines 55-63 of Strandjord et al. merely explains the conventional knowledge that such structures can provide coding signals. Strandjord et al. is silent as to any improvement in the encoding of information by using protrusions.

Accordingly, for this additional reason, favorable reconsideration and withdrawal of the rejection of independent claims 1, 12, and 27 under 35 U.S.C. § 103 are respectfully requested.

In view of the foregoing, Applicants respectfully submit that the independent claims patentably define the present invention over the citations of record. Further, the dependent claims should also be allowable for the same reasons as their respective base claims and further due to the additional features that they recite. Separate and individual consideration of the dependent claims is respectfully requested.


Applicants believe that the present Amendment is responsive to each of the points raised by the Examiner in the Official Action. However, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to such matters.

There being no further outstanding objections or rejections, it is submitted that the present application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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